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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,029	07/15/2003	Garen Eileen Thomas		6901

7590

04/11/2005

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EXAMINER

FRANCIS, FAYE

ART UNIT PAPER NUMBER

3728

DATE MAILED: 04/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,029

Applicant(s)

THOMAS, GAREN EILEEN

Examiner

Faye Francis

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: the abstract of the disclosure [first paragraph on page 1] should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-5 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure, which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Claims are replete with grammatical and idiomatic errors too numerous to specifically point out. For example **only**, note the phrase "said device comprising the combination of a spacing at its center to house the container with an entrance hole on the top" in line 5-7 of claim 1. Corrections are required where they are appropriate.

With respect to claim 1: the phrase "usually liquid" in line 2 is vague as used. It is not clear what other substance the applicant referring to.

With respect to claim 1: it is not clear whether the words in the parentheses are intended to further limit the claim.

With respect to claim 2: the claim language is confusing since it is not clear whether "an aggregate opening" in line 2 is the same opening/hole as in line 7 of claim 1 from which claim 2 depends or is an additional opening.

With respect to claim 4: a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 4 recites the broad recitation a biodegradable and moisture-resistant, leak-proof material, and the claim also recites corrugated cardboard, which is the narrower statement of the range/limitation.

Claim 2 recites the limitation "the top opening and bottom opening" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the edges" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the adhesively joined top surface" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Additionally, the present of the word "its" throughout the claims is confusing since it is not clear what the applicant is referring to.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Shean [1,800,759].

The claims are interpreted as best understood by the examiner, in view of the rejection for indefiniteness set forth above. The claims are interpreted as requiring a container [cone 1], a substance [ice-cream], a corrugated [col 1 lines 39-50] discoid [inasmuch as applicant has defines his device as shown in Fig 4 embodiment to be discoid so is the portion 4 in the device of Shean] protecting device [portion 4 and 4'] including a shield [portion 4] and an opening creating a slope [Fig 2] and made out of moisture-resistant, leak-proof material [col 1 line 35 to col 2 line 67]. Shean is considered to clearly show a device having the structural elements of the claims that can be understood.

As required by claims 4 and 5 the device of Shean is considered to be inherently biodegradable and foldable in as much as the material as disclosed is a paper.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rizzuto [4,938,411].

The claims are interpreted as best understood by the examiner, in view of the rejection for indefiniteness set forth above. The claims are interpreted as requiring a container [cone 20], a substance [ice-cream], a discoid protecting device [drip caching device 10] including a shield [planar member 12] made out of moisture-resistant, leak-proof material [col 1 lines 61-68] and an opening [slits 16 that forms an opening [Figs 2 and 3]].


Although, Rizzuto does not disclose that the device is made out of corrugated material. Rizzuto teaches that it is conventional to make a drip caching device out of corrugated material [col 1 line 34]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device of Rizzuto out of corrugated material to minimize cost and to make the device more durable.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 571-272-4423. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Faye Francis

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